

### **REMARKS**

Claims 42-43, 46-54, 57, 60-64, 73 and 74 are pending. By this amendment, claims 42 is amended for clarification purposes only, and claims 2-6, 16-20, 22-25, 34-40, 55, 66-67, 69, 71, 72, 75 and 76 are canceled without prejudice. No new matter is introduced. The amendment to claim 42 is not intended to surrender any range of equivalents or to be otherwise narrowing.

Applicants thank the Examiner for the courtesies extended during the in-person interview with Applicants' representative, Sean S. Wooden, on June 18, 2003 (the "Interview"). The Applicants' thank the Examiner for indicating during the Interview that he "appears to be persuaded" by the Applicants' arguments, which are described below in detail. Allowance of the pending claims is therefore respectfully requested.

#### **I. REJECTIONS UNDER 35 U.S.C. § 112**

##### **A. Rejections Under 35 U.S.C. § 112, First Paragraph**

As discussed during the Interview, claim 42-43, 46-54, 57, 60-64, 73 and 74 are rejected under 35 U.S.C. § 112, first paragraph in Paper No. 8, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Paper No. 8 states that the specification and drawings fail to support the feature in claim 42 that "the second signal processing components are located on an upgrade card." During the Interview, the Applicants' representative showed how this feature is supported by the specification, as discussed in the following.

On page 17, lines 1-5 of the Detailed Description under the section heading "Set Top Terminal," the specification of the present application states:

In the simplest embodiment, available converter boxes such as those manufactured by General Instruments and Scientific Atlanta, may be modified and **upgraded** to perform the functions of set top terminal **220**. The **preferred upgrade is a circuit card with a microprocessor** which is electronically connected or inserted into the converter box. [Emphasis added].

Then, on page 21, line 16 to page 22, line 2 of the Detailed Description under the section heading "Detailed Set Top Terminal Description," the specification describes hardware components of a preferred embodiment of set top terminal **220**, as seen in Figure 4. These hardware components correspond to the top portion of signal processing components of the set

top terminal 220 shown in Figure 14, and hence, to the first signal processing components in claim 42.

Then, on page 49, lines 12-15 of the Detailed Description under the sub-section heading "Picture-On-Picture Capability" in the section entitled "Advanced Features and Functional Capabilities," the specification describes Figure 14 and states:

Although the preferred embodiment of the present invention decompresses one channel at a time (*e.g.*, one video decompressor as seen in Fig. 4) for the viewer, *users who desire* a picture-on-picture capability can be provided with a set top terminal 220 having upgraded hardware components that allow two or more channels to be tuned (*e.g.*, provided with tuner 603' in addition to tuner 603 in Fig. 14) and decompressed (*e.g.*, provided with decompressor 618' in addition to decompressor 618) at any given time. [Emphasis added].

From these passages, it follows then that the top portion of Figure 14 corresponds to the preferred embodiment shown in Figure 4 and is the first signal processing components in claim 42. Consequently, the bottom portion of Figure 14 (with the primed (*e.g.*, 603') components) is the upgraded hardware components of the set top terminal 220, described on page 49, and the second signal processing components in claim 42. Therefore, since the specification teaches and describes that the "preferred upgrade is a circuit card with a microprocessor," the specification supports the feature that "the second signal processing components are located on an upgrade card" in claim 42. This is further emphasized by the following passage on page 44, lines 21-25 of the Detailed Description:

The use of expansion cards lowers the cost of the set top terminal 220 itself, while also increasing the potential functionality. Thus, an expansion card may include enhanced functional capabilities described as part of the upgrade module discussion above and be designed to accommodate any hardware upgrade compatible with the set top terminal 220. [Emphasis added].

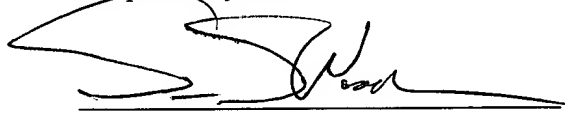
As a result, the specification and drawings reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the invention claimed in claims 42-43, 46-54, 57, 60-64, 73 and 74. Withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

## II. CONCLUSION

In view of the above remarks and the corresponding discussion during the Interview, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



Date: **June 24, 2003**

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